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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,192	01/23/2002	Glenn W. Gengel	03424P056	3828

7590 12/13/2005

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EXAMINER

PIZARRO CRESPO, MARCOS D

ART UNIT PAPER NUMBER

2814

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H/A

Office Action Summary	Application No. 10/056,192	Applicant(s) GENGEL ET AL.	
	Examiner Marcos D. Pizarro-Crespo	Art Unit 2814	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22,37-60,99-102 and 105-111 is/are pending in the application.
- 4a) Of the above claim(s) 10-18 and 49-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-22,37-60,99-102 and 105-111 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Attorney's Docket Number: 03424P056

Filing Date: 1/23/2002

Claimed Foreign Priority Date: none

Applicant(s): Gengel et al.

Examiner: Marcos D. Pizarro-Crespo

DETAILED ACTION

This Office action responds to the election filed on 11/21/2005.

Acknowledgment

1. The amendment filed on 11/21/2005, responding to the Office action mailed on 10/17/2005, has been entered. The present Office action is made with all the suggested amendments being fully considered. Accordingly, pending in this Office action are claims 1-22, 37-60, 99-102, and 105-111.

Election/Restrictions

2. Applicants' election of species 1 in the reply filed on 11/21/2005 is acknowledged. Because the applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). In their reply, the applicants indicated that claims 1-22, 37-60, 99-102, and 105-11 read on the elected species. As indicated in the restriction requirement mailed on 10/17/2005, species 1 reads on figure 4 showing an antenna as the large-scale component of the elected species. Claims 10-18 and 49-55, however, recite different large-scale components than that of the elected species. Accordingly, claims 10-18 and 49-55 are withdrawn from further consideration

pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, 19-22, 37-48, 56-60, 99-102, 105-107, and 111, drawn to a semiconductor package, classified in class 257, subclass 678.
- II. Claims 108-110, drawn to a spool, classified in class 206, subclass 701.

4. The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

5. In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed. For example, the spool of claim 108 may comprise a metal plug electrically attaching the conductive medium to the conductive pad instead of the conductive medium having direct electrical connection to the integrated circuit as recited in claim 37. The subcombination, on the other hand, has separate utility. For example, the semiconductor package of claim 37 may be part of a logic-based system instead of the spool of claim 108.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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7. Each of the combination and subcombination groups above also contains claims directed to the following patentably distinct species of the claimed invention:

- Species 1, reading on an apparatus wherein the conductive medium is a paste
- Species 2, reading on an apparatus wherein the conductive medium is an electrically conductive paste
- Species 3, reading on an apparatus wherein the conductive medium is metal particles suspended in a carrier
- Species 4, reading on an apparatus wherein the conductive medium is a thermosetting polymer with conductive filler
- Species 5, reading on an apparatus wherein the conductive medium is a thermoplastic polymer with conductive filler
- Species 6, reading on an apparatus wherein the conductive medium is a carbon-based conductor
- Species 7, reading on an apparatus wherein the conductive mediums is a solder
- Species 8, reading on an apparatus wherein the conductive medium is silver ink

8. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there is no apparent generic claim.

9. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

10. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

11. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

12. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

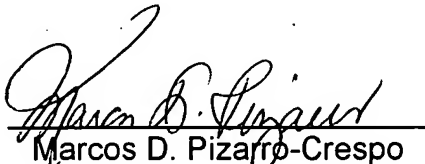
Conclusion

13. Papers related to this application may be submitted directly to Art Unit 2814 by facsimile transmission. Papers should be faxed to Art Unit 2814 via the Art Unit 2814 Fax Center. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The Art Unit 2814 Fax Center number is **(571) 273-8300**. The Art Unit 2814 Fax Center is to be used only for papers related to Art Unit 2814 applications.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Marcos D. Pizarro-Crespo** at **(571) 272-1716** and between the hours of 9:30 AM to 8:00 PM (Eastern Standard Time) Monday through Thursday or by e-mail via Marcos.Pizarro@uspto.gov. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy, can be reached on (571) 272-1705.

15. Any inquiry of a general nature or relating to the status of this application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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